



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2015-0074]

Request for Submission of Topics for USPTO Quality Case Studies

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Initiation of Pilot Program and Request for Program Topics.

SUMMARY: The United States Patent and Trademark Office (USPTO) is initiating a new pilot program as part of its Enhanced Patent Quality Initiative. Currently, the USPTO performs reviews of applications on target issues for internal quality purposes, referred to as “case studies.” The USPTO now seeks to leverage the experience of its stakeholders to expand the use of case studies to additional quality-related topics.

Beginning immediately, stakeholders are invited to submit patent quality-related topics that they believe should be the subject of a case study. After considering the submitted topics, the USPTO will identify which topics will be the subject of upcoming case studies. The USPTO anticipates that the results of these case studies will help it to

understand better the quality of its work products and, where appropriate, to take action to remediate quality issues or to formulate best practices to further enhance quality. Such public engagement is sought not only to broaden the scope of quality issues currently studied by the USPTO, but also to continue stakeholder involvement in the quality review process and to maintain a transparent quality enhancement process.

DATES: Submissions deadline date: To be ensured of consideration, written topic submissions must be received on or before February 12, 2016.

ADDRESSES: Written submissions should be sent by electronic mail message over the Internet addressed to: TopicSubmissionForCaseStudies@uspto.gov. Submissions may also be submitted by postal mail addressed to: Mail Stop Comments Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, marked to the attention of Michael Cygan, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Although submissions may be sent by postal mail, the USPTO prefers to receive submissions by electronic mail message over the Internet because sharing submissions with the public is more easily accomplished.

Electronic submissions are preferred to be formatted in plain text, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Submissions not sent electronically should be on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

Timely filed submissions will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia 22314. Submissions also will be available for viewing via the USPTO's Internet Web site (http://www.uspto.gov/patents/init_events/Patent-Quality-Initiative.jsp). Because submissions will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included. It would be helpful to the USPTO if written submissions included information about: (1) the name and affiliation of the individual responding; and (2) an indication of whether submissions offered represent views of the respondent's organization or are the respondent's personal views.

FOR FURTHER INFORMATION CONTACT: Michael T. Cygan, Senior Legal Advisor, at (571) 272-7700; Maria Nuzzolillo, Legal Advisor, at (571) 272-8150; or Jeffrey R. West, Legal Advisor, at (571) 272-2226.

SUPPLEMENTARY INFORMATION:

I. The Enhanced Quality Initiative

On February 5, 2015, the United States Patent and Trademark Office (USPTO) launched an enhanced quality initiative to improve the quality of patents issued by the USPTO.

This initiative began with a request for public comments on a set of six proposals outlined in a document in the Federal Register, [Request for Comments on Enhancing Patent Quality](#), 80 FR 6475 (Feb. 5, 2015). The USPTO also held a two-day "Quality

Summit” on March 25 and 26, 2015, at the USPTO headquarters in Alexandria, Virginia, to discuss the quality concerns of patent stakeholders and to receive feedback on the USPTO’s proposals. Following the Quality Summit, the USPTO has continued its engagement with the public through numerous roadshows, events, and stakeholder meetings to further refine the steps that may be taken to improve quality.

The enhanced patent quality initiative targets three pillars of patent quality: 1) excellence in work products; 2) excellence in measuring patent quality; and 3) excellence in customer service. As part of the first pillar, the USPTO is focusing on the quality of the work products provided at every stage of the patent process, including the actions taken by the USPTO during application processing, examination, and issuance processes, as well as the quality of issued patents. The USPTO originally proposed creating a mechanism by which the public could flag particular applications to the Office of Patent Quality Assurance (OPQA) for review. After considering the comments from both our internal and external stakeholders, the USPTO decided to revise its original proposal. The USPTO is, instead, implementing a pilot program in which stakeholders are invited to submit patent quality-related topics, not particular applications, they believe should be the subject of a case study.

II. Case Studies at the USPTO

The USPTO performs case studies to investigate specific quality-related issues in addition to reviews of individual examiner work products, such as its review of a sampling of first Office actions on the merits. The USPTO designs, and performs, these

case studies to investigate whether the quality-related issues that are the subject of these studies exist. If the result of a case study reveals that action is needed, the USPTO takes the necessary action. For example, if the result of the case study reveals that additional training is needed, the USPTO develops and implements the training. Unlike the USPTO's review of specific Office actions in an individual application, case studies allow the USPTO to investigate how a particular issue is being treated or addressed across hundreds or thousands of applications. The USPTO historically has performed case studies for internal quality purposes.

III. Topic Submission for Case Studies Pilot Program

This new pilot program invites the public to submit topics for case studies. Submissions may concern any topic affecting the USPTO's ability to effectively issue high-quality patents. A submission should be more than a mere statement of an issue or problem encountered by the submitter. A submission should propose a specific correlation or trend for study, and where possible, suggest a methodology for its investigation. A helpful submission would also explain how the results of that case study could be used to improve patent quality. The submission may refer to concrete examples to support the proposed correlation or trend, but any such examples should not contain information sufficient to identify any particular application, any particular examiner, or any particular art unit. A submission may specify certain data subsets for analysis, e.g., primary vs. junior examiners, or data broken out for each Technology Center. Finally, the submission should identify any relevant dates of concern that pertain to the issue presented, e.g., dates of a particular court opinion or USPTO guidance document.

The following restrictions are placed on submissions. First, each separate topic must be presented in a separate submission to ensure consideration, although there is no limit placed upon the number of submissions from a person or entity. Second, each submission should be titled, such as in an email's "subject" line, to reflect the topic contained therein. Third, submissions should not contain information associated with any particular patent application or patent, any particular examiner, or any particular art unit; any such submission will not be part of the study. Fourth, topics should focus on patent quality issues; topics relating to other issues such as management concerns or statutory changes are outside the scope of these case studies. Fifth, the submission should concisely explain the nature and purpose of the proposed study to aid the USPTO in selecting the best topic(s) for this pilot program; the submission should not include lengthy supporting documentation or arguments.

The USPTO will consider these suggestions and identify potential areas for quality case studies in addition to those already being conducted by OPQA. The USPTO will use the results of the studies to improve its understanding of the quality of its work products and, where appropriate, to take action to remediate quality issues or to formulate best practices to further enhance quality. For example, if a case study reveals a training issue, the USPTO will develop and deliver the appropriate training.

This pilot program will help the USPTO determine the usefulness of this manner of public submission for case study topics as compared to currently-existing methods, such

as public fora and external quality surveys. In addition, this pilot program will allow the USPTO to communicate to the public the case studies determined to be useful and the results of those studies.

IV. Example of a Topic Submission

The following example is provided to assist the public in providing high-quality submissions that best communicate a focused case study topic for consideration:

Title: “Pre-first action interviews and quality of the resulting patent prosecution.”

Proposal for study: “Pre-first action interviews result in a shorter time-to-issuance in such applications that are issued as patents.”

Explanation: In my experience as a patent practitioner, interviews with examiners lead to better understanding of the claimed invention by both parties. In particular, interviews can reveal that the parties are operating under differing understandings of the scope of the claims, the meaning of a claim term, or interpretation of a teaching of the prior art. When performed early in prosecution, these can provide the opportunity to resolve such differences before the mutual misunderstanding or miscommunication results in extended prosecution. This permits more efficient examination as reflected by a shorter prosecution time for those applications that eventually mature into patents. These efficiency gains are most noticeable after April 1, 2011, when the Full First Action Interview Pilot Program went into effect. The USPTO should study what effect an interview before the first action on the merits in a new application has on time-to-allowance in applications that are eventually issued as patents, and if there are any particular features of the interview that strongly correlate with the time-to-allowance.

Discovery of such correlations could lead to USPTO process changes or changes in applicants' approach to prosecution that could improve the overall efficiency and effectiveness of patent prosecution.

Dated: December 15, 2015.

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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